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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,376	12/21/2001	Stephen Quirk	1443.008US1	5459

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

AUDET, MAURY A

ART UNIT PAPER NUMBER

1654

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,376

Applicant(s)

QUIRK, STEPHEN

Examiner

Maury Audet

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 2-13, 16-26 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 14-15, and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/03 & 09/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Groups I-II, claims 1-28, as drawn to SEQ ID NOS: 8-10, in the paper filed 09/02/2004 is acknowledged. Applicant's amendment of the claims in the paper filed 09/02/2004 to be limited to SEQ ID NOS: 8-10 is acknowledged. Claims 1-28 are pending. Claims 2-13, 15-26, and 28 have been withdrawn by Applicant and are herein withdrawn from further consideration. It is suggested that these claims be "canceled" in response to this action. Claims 1, 14-15, and 27 are examined on the merits.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 14-15, and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As drafted, the claims read upon a product of nature (i.e. a non-isolated peptide). It is suggested that Applicant insert the phrase "an isolated" or the like before the term "peptide" in claims 1, 14-15, and 27, in order to show the hand of man and thus statutory subject matter.

All other claims depend directly or indirectly from rejected claims and are, therefore, also rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 14-15, and 27, as drawn to SEQ ID NO: 8, are rejected under 35 U.S.C. 102(e) as being anticipated by Falduto et al. (US 6,39937 B1). Applicant's invention is drawn in part to a peptide/products using elected SEQ ID NO: 8. Falduto et al. teach a 707 residue peptide (SEQ ID NO: 20) with 100% homology (residues 74-120) to Applicant's elected SEQ ID NO: 8 and products using such (col. 8, lines 28-32).

Claims 1, 14-15, and 27, as drawn to SEQ ID NO: 9, are rejected under 35 U.S.C. 102(e) as being anticipated by Dack et al. (2003/0199440 A1). Applicant's invention is drawn in part to a peptide/products using elected SEQ ID NO: 9. Dack et al. teach a 469 residue peptide (SEQ ID NO: 23) with 100% homology (residues 67-120) to Applicant's elected SEQ ID NO: 9 and products using such (abstract).

Claims 1, 14-15, and 27, as drawn to SEQ ID NO: 10, are rejected under 35 U.S.C. 102(e) as being anticipated by Dack et al. (2003/0199440 A1). Applicant's invention is drawn in part to a peptide/products using elected SEQ ID NO: 10. Dack et al. teach a 467 residue peptide (SEQ ID NO: 31) with 100% homology (residues 66-120) to Applicant's elected SEQ ID NO: 10 and products using such (abstract).

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In order to overcome the rejections above, it is suggested that Applicant amend claims 1, 14-15, and 27, by deleting the open transition phrase "comprising" and inserting "consisting of".

Double Patenting

Claims 1, 14-15, and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-73 (i.e. claims 1 and 63) of copending Application No. 10/219,561 (Quirk et al., 2003/0166567 A1) and claims 1-40 (i.e. claims 18 and 23) of copending Application No. 10/219,329 (Quirk et al., 2003/0096757 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because 10/219,561 and 10/219,329 claims the same peptides (SEQ ID NOS: 8-10, among the various other peptides claimed) and compositions/products using the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached from 7:00 AM – 5:30 PM, off Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached at 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

MA

11/29/04



CHRISTOPHER R. TATE
PRIMARY EXAMINER